



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,521	07/08/2000	Frank Dean	LIDO:003	9294

7590

09/04/2002

Karen B Tripp
Attorney at Law
P.O. Box 1301
Houston, TX 77251-1301

EXAMINER

TRUONG, DUC

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 09/04/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/611,521

Applicant(s)

DEAN, FRANK

Examiner

Duc Truong

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30, 32, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 12-14, 16-18, 20-22, 24-26, 28-30, 32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-11, 15, 19, 23 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1711

The rejection made over the Specification in the use of original formulas and in the use of the term "may be " have been withdrawn in view of Applicant's amendment.

Applicant's arguments filed 8/12/02 have been fully considered but they are not persuasive. The amendment submitted by Applicant does not overcome the rejection made by Examiner in the last Office action.

The specification is objected to under 37 CFR 1.71 because failing to provide an adequate written description of the invention, as disclosed on page 15, line 10, line 12 and elsewhere in the specification, Me can not be defined as an alkali metal since Me(OH) is methanol and the methyl group does not belong to the alkali metal group. Claims 15 and 23 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the Specification and for the following reasons:

While it is established that Applicant can be his own lexicographer, that is provided that the definitions are not in derogation of the known usage or are already recognized, as in the instant case, MeOH is well known in the art as methanol.

Claims 1,6-11,15,19,23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 2,285,308.

The rejection is maintained for the reasons as stated in the last Office action and for the following reasons:

Applicant's arguments are based on different steps of the processes to form a different product, a chelating composition comprising a modified iminodisuccinic acid, or a salt thereof.

Art Unit: 1711

Note that claim 1 is the claimed composition requiring variety of formulas in that specific steps have not been claimed. This composition has been produced by the claimed method 6, 11, 15, 19, 23 and 27. That means any references using any claimed methods and the same conditions inherently has the claimed formulas and can be used in a chelating composition.

The CA 2,285,308 reference does disclose the required reactants and the steps of the process, as in claimed method 19. Therefore, the claimed formula must be considered inherent in the prior art unless Applicant provides evidence that they are different.

Applicant argues that the reference produces isomers of iminodisuccinate which is differed from the claimed products. Note that the reference does disclose the required reactants and the steps of the claim 19. Therefore, the products must be inherently the same. Further, this is the salt form of a modified iminodisuccinimic acid, as in claim 1.

Applicant's arguments based on the chelated ion has been fully considered but they are not persuasive since they are not commensurate in scope with the claims.

The specification is objected to under 35 U.S.C. 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as now claimed, in the use of $M(OH)$, as disclosed in the amended claims 11 and 19, and is not defined.

Claims 11 and 19 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

Art Unit: 1711

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "polyfunctional amine and second polyfunctional amine" in claim 8 is used by the claim to mean "ethanol amine and NH₃," while the accepted meaning is "more than one amino group."

Claims 6, 9, 11, 15 and 19 are also confused by the definition in claim 8.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1711

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 703-308-2437. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9791 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DT
September 3, 2002

A handwritten signature in black ink, appearing to read 'Duc Truong', with a stylized flourish at the end.

DUCTRUONG
PRIMARY EXAMINER